

REMARKS

Applicants have herein amended claims 24, 34, 35, 40, 42, and 43 and cancelled claims 48-51 without prejudice. In claims 24 and 40, the list of solvents suitable for use as the second organic solvent in the purification processes claimed herein, explicitly described in the specification on p. 7, lines 25-36, is now incorporated into these claims. This is consistent with the list of solvents incorporated into claim 40 in the Response filed on October 23, 2002, except the problems with the improper Markush group format have been corrected by elimination of the second "and" in the list of solvents, and proper inclusion of the word "acetate" for all listed esters. Also, as stated previously, support for the listing of solvents having limited miscibility with water is found in the specification on p. 7, lines 25-36. In addition, claim 40 is herein amended to include the phrase "having limited miscibility with water" in the description of the second organic solvent. Support for this amendment is found in the application on p. 6, lines 35-37. This amendment is added for clarity to distinguish the second organic solvent from the first, to be consistent with the language of claim 24, and to be consistent with the language of the specification.

In the Response D filed on December 12, 2003, claim 40 was amended to delete the solvent "acetonitrile" from the list of solvents having limited miscibility (or solubility) with water (i.e. suitable for use as the second organic solvent in the purification processes claimed herein) because acetonitrile is totally miscible in water, as those skilled in the art know. As currently amended, claim 24 also includes a list of solvents having "limited miscibility with water" and the list does not include acetonitrile. Although the Examiner objects to this deletion as addition of new matter (see p. 3 of the

Office Action of February 20, 2004), Applicants respectfully reiterate that this amendment does not constitute new matter, but is merely correction of obvious error.

Further, the Specification is herein amended to correct the same error on p. 7, line 35 of the application by replacing the only full paragraph on p. 7 with a replacement paragraph that lacks the solvent acetonitrile as an example of a solvent having limited miscibility or solubility with water because, 1) the inclusion of acetonitrile in the list of solvents having limited miscibility or solubility with water is clearly in error, and 2) for reasons of consistency with the claims.

Applicants respectfully submit that none of these amendments – not the previous amendment to claim 40, the current amendment to claim 24, nor the current amendment to the specification on p. 7, line 35 – constitutes addition of new matter. Applicants respectfully submit that one skilled in the art would instantly recognize that acetonitrile does not meet the requirements for an organic solvent which must have “limited miscibility or solubility with water” (see specification, p. 6, lines 35-37) since those skilled in the art know that acetonitrile is completely miscible/soluble with water. As stated in MPEP § 2163.07(II), “An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.” (*In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971)).

Claims 34, 35, 42, and 43 have been amended to delete the phrase “or water soluble” for reasons of clarity. Claims 48-51 have been cancelled, without prejudice. Applicants herein retain the option to pursue any original or cancelled claim at a later date in a continuation or divisional application.

In addition, the specification has been amended to remove the added paragraph and Table 1 from Ullman's Encyclopedia of Industrial Chemistry that was originally incorporated by reference in the application, and then added at p. 7, line 15 in the Response F filed on December 12, 2003. Applicants respectfully submit that removal of the added text to the original text does not constitute addition of new matter.

Finally, Applicants would like to state for the record that the concept of a solvent having "limited miscibility or solubility with water" is instantly recognizable and known by those skilled in the art, as stated in the specification on p. 7, lines 1-4 ("The property of the organic solvent ... having a limited miscibility or solubility with water is per se known to the man skilled in the art"). Applicants respectfully submit that the Examiner has supplied no evidence that one skilled in the art would not understand this concept, and has supplied no evidence that one skilled in the art would not understand and recognize the scope of a claim containing this term without an express listing of example solvents. The Examiner has instead maintained the rejection of claims containing this term for reasons of indefiniteness based solely on the asserted that the term "limited" is relative, and so those skilled in the art would be unable to determine the meets and bounds of claims containing this term. In contrast, Applicants submit that the term "limited miscibility" is a term of art readily understood by those skilled in the art as representing solvents which are not completely miscible in water - i.e., as defined in The American Heritage Dictionary: "having a limit or limits", wherein the concept of "limit" is defined as "establishing a maximum, as in quantity, degree, space, or time, beyond which a person or thing cannot or may not go." Therefore, Applicants would like to state for the record that the term "having limited miscibility or solubility with water" is

immediately understood by those skilled in the art, that it is not relative but encompasses a maximum for each solvent having limited miscibility with water that is less than 100% miscibility with water, and that claims containing this limitation are not indefinite. Having so stated, Applicants reserve the right to pursue such claims in a continuation or divisional application at a later date.

CONCLUSION

Claims 24 and 40 are amended to add a specific list of solvents suitable for use as the second organic solvent in the purification processes claimed herein, as outlined above. Claims 34, 35, 42, and 33 are amended to remove the phrase "or water soluble" for reasons of clarity. Claims 48 – 51 are cancelled without prejudice. The specification has been amended to delete acetonitrile from the list of solvents having limited miscibility or solubility with water on p. 7, line 35. No new subject matter has been added by these amendments.

For the reasons set forth above, it is submitted that all pending claims are in condition for allowance. Reconsideration of the claims and a notice of allowance are therefore requested. Applicants do not believe an extension of time is required. However, in the event that an extension of time has been overlooked, Applicants submit this conditional petition for an extension of time, and request that deposit account number 19-4972 be charged for any fees that may be required for the timely consideration of this application. The Examiner is requested to telephone the undersigned if any matters remain outstanding so that they may be resolved expeditiously.

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Respectfully submitted,



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